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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No.	:	10/026,579
Applicants	:	Francisco Jose Paz Barahona
		Timothy C. Loose
Filed	:	December 19, 2001
Title	:	GAMING MACHINE WITH AMBIENT NOISE ATTENUATION
TC/A.U.	:	3713
Examiner	:	John M. Hotaling
Docket No.	:	47079-000124USPT

AMENDED SUPPLEMENTAL APPEAL BRIEF

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Commissioner for Patents
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Dear Commissioner:

This Amended Supplemental Appeal Brief is submitted pursuant to a notification of Non-Compliant Appeal Brief under 37 C.F.R. § 41.37(c)(1)(vi) mailed September 9, 2005. The time period for response is one month or thirty days from the mailing date, *i.e.*, by October 10, 2005 (wherein October 9, 2005 falls on a Sunday).

After the Applicants filed the Appeal Brief on February 23, 2004, prosecution has been reopened and a new ground of rejection was entered in an Office Action dated May 5, 2004. After the Applicants responded to the Office Action, in a Response dated July 15, 2004, a Final Office Action was entered on December 9, 2004. In accordance with 37 C.F.R.

§ 1.193(b)(2)(ii), the Applicants have requested reinstatement of the Applicants' appeal to the Board of Patent Appeals and Interferences from the rejection of claims 14-23 and 25-29, and have filed a Supplemental Appeal Brief in support of the request on March 4, 2005. In response to the filing of the Supplemental Appeal Brief, the notification of Non-Compliant Appeal Brief was mailed on September 9, 2005.

The notification of Non-Compliant Appeal Brief noted that the "brief does not contain a concise statement of each ground of rejection presented for review," wherein "grounds of rejection to be reviewed on appeal replaced 'issued for review' and 'grouping of claims.'" The Applicants note with appreciation the telephone conference conducted on September 28, 2005 with Examiner John Hotaling. During the telephone conference, the Examiner clarified that section "6. Issue" and section "7. Grouping of Claims," as filed in the original Appeal Brief of February 23, 2004 (pursuant to 37 C.F.R. § 1.192) should be replaced by section "6. Grounds of Rejection To Be Reviewed On Appeal" (pursuant to 37 C.F.R. § 41.37). Thus, the Applicants submit this Amended Supplemental Appeal Brief to comply with the notification of Non-Compliant Appeal Brief. The Amended Supplemental Appeal Brief supplements, but does not supersede, the Supplemental Appeal Brief.

The Applicants incorporate by reference sections 1-5 of the original Appeal Brief.

6. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The ground of rejection presented for review in this Appeal is whether claims 14-23 and 25-29 are patentable under 35 U.S.C. § 103(a), wherein claims 14-23 and 25-29 have been rejected as being obvious over U.S. Patent Number 5,851,148 to Brune et al. ("Brune") in view of U.S. Patent Number 5,828,768 to Eatwell et al. ("Eatwell") and further in view of U.S. Patent Number 5,133,017 to Cain et al. ("Cain") and in view of JP 10-277213A ("Heiwa").

7. ARGUMENT

The Applicants incorporate by reference the Argument section of the original Appeal Brief. Thus, all the previously-raised arguments are still considered to be relevant. For example, the previously-raised arguments include:

- the argument that the Examiner has misconstrued Brune and its teachings regarding desktop and laptop computers;
- the argument that the active noise reduction (ANR) of Eatwell focuses the antinoise signal at the microphone to create a quiet zone at the microphone – not at the user of the personal computer;
- the argument that Cain cannot be combined with Eatwell because there is no suggestion for combining Cain's headrest system with Eatwell's personal computer; and
- the argument that the cited references do not teach all of the claim limitations – a gaming machine for broadcasting to the player (i) game sounds coordinated with the displayed representation and (ii) anti-noise sounds so as to enhance the game sounds.

Each of these four arguments, by itself, would overcome the previous three-reference obviousness rejection and the current four-reference obviousness rejection. Furthermore, the addition of the fourth reference to this combination presents yet another (*i.e.*, a fifth) substantial argument to overcome the Examiner's new ground of rejection.

In an Office Action, dated May 5, 2004, the Examiner has acknowledged the receipt of the appeal filed on February 23, 2004, and has withdrawn the final rejection in view of newly discovered art. Office Action of May 5, 2004 ("New Office Action"), attached as Appendix J. In the New Office Action, the Examiner simply added a new fourth reference to the previously used three-reference obviousness rejection that the Applicants disputed in the Appeal Brief. The Examiner did not respond to any of the Applicants' arguments, simply stating that "Applicant's arguments with respect to claims 14-23 and 25-29 have been considered but are moot in view of the new ground(s) of rejection." *Id.* at p. 4. The Applicants consider the New Office Action to be an unfair response because the fundamental arguments in the original Appeal Brief regarding why the three-reference combination must fail were never discussed. These previously submitted arguments were (and are) still applicable.

To put a quick end to the issue, the Applicants chose to file a response addressing the new ground of rejection (rather than reinstate the Appeal at that time), and noted that the New

Office Action had not addressed any of the Applicants' previous arguments. Response To Office Action Dated May 5, 2004, attached as Appendix K. In a Final Office Action, the Examiner reiterated the position taken in the New Office Action. Final Office Action Dated December 9, 2004, attached as Appendix L.

I. The Newly Added Reference Does Not Teach The Reduction Of Ambient Noise In A Gaming Establishment

The new ground of rejection simply consists of the addition of a fourth reference, Heiwa, to the combination of Brune, Eatwell, and Cain, which was previously used to reject the claims. Accordingly, claims 14-23 and 25-29 are now rejected under 35 U.S.C. § 103(a) as being unpatentable over Brune in view of Eatwell in view of Cain and further in view of Heiwa. Regarding Heiwa, the following documents have been included: an English abstract of Heiwa provided by the Japanese Patent Office website (two pages) ("JPO Abstract"), attached as Appendix M; a mechanical English translation of the Heiwa claims provided by the Japanese Patent Office website (two pages), attached as Appendix N; a mechanical English translation of the Heiwa specification provided by the Japanese Patent Office website (twenty-two pages), attached as Appendix O; a Japanese copy of Heiwa (thirty-one pages), attached as Appendix P; and an alternative English abstract of Heiwa provided by Thomson Derwent (one page), attached as Appendix Q.

Specifically, in the Final Office Action the Examiner has made the following allegation:

> Heiwa teaches that pachinko game machines can have built in noise reduction units to reduce the noise from the game machines. The system facilitates noise reduction in response to predetermined conditions from the exterior of the game machine. Thus, Heiwa provides further evidence that it was known in the art at the time of the invention to reduce ambient noise in gaming halls though [sic, through] the use of the noise reduction systems.

Appendix L, p. 3 (emphasis added).

The inclusion of Heiwa, in fact, only bolsters the Applicants' position. The problem sought to be solved by Heiwa is related to allowing a player to hear messages broadcasted through a gaming establishment's public address system ("p.a. system"). Appendix M. For

example, Heiwa notes that the goal of the invention is to "make sound easier to hear, when transmission in a game parlor or back ground music is output using conventional transmission equipment," if a specified condition is satisfied. *Id.* Heiwa describes a specified condition being, for example, a worker that switches a microphone 12 to an ON position and, then, raises a volume knob 13 of the microphone 12 to a preset volume level for playing background music (*e.g.*, music for closing time) over the p.a. system. According to Heiwa, the background music "takes precedence over playing sound of pachinko machines." *Id.* In other words, the sounds of a pachinko machine are replaced by the sounds of the p.a. system.

Thus, the system disclosed by Heiwa is a game-establishment sound system that overrides sounds produced by a particular pachinko machine. In contrast, the current invention is directed generally to a gaming-machine sound system that, to an extent, overrides ambient noise sounds (*e.g.*, sounds produced by a p.a. system). Heiwa discloses a system plagued with one of the exact type of problems that the present invention seeks to eliminate.

Based on the Examiner's allegations, although not clear, it seems that the use of Heiwa is directed to rebutting the following statement made by the Applicants in the Appeal Brief:

> Furthermore, none of the references mentions anything about ambient noise in a gaming establishment, much less that ambient noise in gaming establishment is a problem . . . .

Appeal Brief, p. 7. If the "problem" solved by the present invention had been a player's ability to hear information transmitted over an establishment's p.a. system, then the reduction of noise taught by Heiwa might have been relevant. However, the "problem addressed by the Applicants is to provide a gaming machine that enhances its game sounds by minimizing interference from ambient noise produced by the surrounding environment." *Id.* at pp. 8-9 (emphasis added).

The Heiwa system does the opposite of the claimed system. While the Heiwa system is directed to shutting-down the sounds from a game machine, the system of the present invention is directed to enhancing the sounds from the game machine. Thus, in contrast to

the system of the present invention, the Heiwa system increases ambient noise by shutting-down, or reducing, the sounds of a particular game machine.

In short, the new position for rejecting the claims combines four different references, one of which, Heiwa, teaches the skilled artisan to do exactly the opposite of the present invention. If anything, Heiwa provides further support for the non-obviousness of the present invention by advocating and emphasizing one type of problem that the present invention seeks to solve. *See, e.g., In re Grasselli*, 713 F.2d 731, 743, 218 U.S.P.Q. 769, 779 (Fed. Cir. 1983) (stating that it is improper to combine references where the references teach away from their combination); and Manual Of Patent Examining Procedure, Eighth Edition, Incorporating Revision No. 1, February 2003, § 2145 (X)(D)(1), page 2100-162 (stating that a "prior art reference that 'teaches away' from the claimed invention is a significant factor to be considered in determining obviousness").

II. The Newly Added Reference Does Not Teach The Enhancing Of Game Sounds

In an apparent attempt to further support his reasoning, the Examiner quotes the following two paragraphs from the Heiwa specification:

> [0033] Furthermore, invention of claim 10 constitutes a game machine including a modification means to change the loudness level of sound of the game sound outputted by output means to output a game sound according to a game condition, sound-volume judging means to judge the loudness level of sound of alien frequencies, and said output means into the loudness level of sound defined corresponding to the loudness level of sound of the alien frequencies judged by said sound-volume judging means . . . .
>
> [0061] Moreover, when carrying out [sound/game] noise reduction by the demand I from the hole computer 10 . . . .

Appendix O, pp. 5-6, 9. The citation is followed by the Examiner's own interpretation of the cited text, noting that the "examiner reads this statement to mean that the game sounds can be enhanced or lowered depending on the desires of the game operator." Appendix L, p. 4 (emphasis added).

Just like the overall rejection is based on taking selective bits and pieces from a string of prior art references without considering their teachings as a whole, the Examiner is now selectively quoting bits and pieces from the specification of Heiwa, without considering the teachings of Heiwa as a whole. The Examiner concludes, without any substantive support, that the phrase "change the loudness level of sound of the game sound" means the same thing as "enhancing" the game sounds. *Id.* While the Examiner "reads this statement to mean that the game sounds can be enhanced," the specification of Heiwa contradicts the Examiner's interpretation. *Id.*

The text cited by the Examiner does not mention anywhere anything about "enhancing" any game sounds. The text cited by the Examiner merely describes a change of game sounds. Instead of searching for the definition of the term "change" by analyzing the Heiwa specification as a whole, the Examiner has apparently substituted his own definition.

A proper analysis of Heiwa shows that it does not teach anything about "enhancing" game sounds. In fact, Heiwa teaches the exact opposite. As described in the above section, the game sounds of the gaming machines of Heiwa are reduced to allow a player to hear messages or music broadcasted over the p.a. system. When Heiwa describes the change in the game sounds, it always describes the game sounds as being reduced or turned off.

For example, if broadcasting of a message does not occur, then the game sounds are not reduced:

> [0142] . . . That is, the usual attenuator data set at first are held, and the sound-volume attenuation level of a game sound is set to 0dB. When you have no broadcast, naturally it is because it is not necessary to make sound volume of a game sound small.

Appendix O, p. 17 (emphasis added). When a particular type of audio output is being transmitted over the p.a. system, such as background music, then the game sounds are reduced:

> [0143] Moreover, when the game sound precedence BGM is being passed, the hole computer 10 sends out a demand command ("H"" H", "L"). . . . Since priority is given to some

> extent to a game sound, the magnitude of attenuation of the sound volume of a game sound is stopped small."

Id. (emphasis added). In another example, Heiwa teaches that the game sounds are "muffled":

> [0147] Moreover, when broadcasting the advice of the close of this pachinko machine, the hole computer 10 sends out a demand command ("L"" H", "L"). The pachinko machine which received this command adds 15 to the usual attenuator data as sound-volume attenuation data. At this time, it is muffled [sound / game] thoroughly (OFF). It is because it is necessary to tell a game visitor so that there may be no failure in hearing of advice of the close."

Id. (emphasis added). The above citation reinforces the goal of the Heiwa invention, which is to allow a player of the gaming machine to hear information broadcasted over the p.a. system. In a further example, Heiwa clarifies that the ambient noise of the gaming establishment is not a factor in changing the level of the game sounds:

> [0158] As drawing 20 and drawing 21 show, the pachinko machine 24 concerning the gestalt of the 4th operation is equipped with the sound-collecting microphone 141 which detects an acoustic wave and is changed into an electrical signal. In addition, it is more desirable to use a directive high thing so that this sound-collecting microphone 141 may not catch a surrounding sound as much as possible but only the announcement over a store's public address system and BGM from a loudspeaker 22 may be detected.

Id. (emphasis added). It is the objective of Heiwa to change, *i.e.*, reduce, the level of the game sounds based only on audio information transmitted via the p.a. system.

Thus, the meaning of the term "change," based on the specification of Heiwa, has nothing to do with enhancing game sounds. Heiwa specifically describes the game sounds as being reduced or turned off, based on audio information transmitted via the p.a. system, to allow a player to hear the audio information. Accordingly, Heiwa fails to address the arguments presented by the Applicants in the original Appeal Brief.

III. The Examiner Has Failed To Address And/Or Has Mischaracterized The Applicants' Arguments

Reliance on Heiwa has nothing to do with the Applicants' arguments that "the Examiner has misconstrued Brune and its teachings regarding desktop and laptop computers," that "the Active Noise Reduction (ANR) of Eatwell focuses the antinoise signal at the microphone to create a quiet zone at the microphone – not at the user of the personal computer," that "Cain cannot be combined with Eatwell because there is no suggestion for combining Cain's headrest system with Eatwell's personal computer," and that "the cited references do not teach all of the claim limitations – a gaming machine for broadcasting to the player (i) game sounds coordinated with the displayed representation and (ii) anti-noise sounds so as to enhance the game sounds."

The Examiner's cursory note regarding the Applicants' arguments does not provide any substantive support for the Examiner's rejection of the claims of the present invention. For example, the Examiner alleges that "[r]educing ambient noise from a gaming hall while not specifically stated can be inferred from a reading of the above references." Appendix L, p. 6. Besides noting that one can infer a reduction of ambient noise in a gaming hall by reading the above references, the Examiner provides no substantive support. There are no quotes or citations showing the basis for the Examiner's allegation. In fact, as discussed above, the references teach away from the Examiner's alleged inference (*e.g.*, Heiwa teaches that ambient noise of the system is increased).

In addition, the Examiner notes that "[i]n response to applicant's argument that the examiner has combined an excessive number of references, reliance on a large number of references in a rejection does not, without more, weigh against the obviousness of the claimed invention." Appendix L, p. 6. The Examiner supports this note with a decision of the Federal Circuit Court of Appeals. *In re Gorman*, 933 F.2d 982, 18 U.S.P.Q. 2d 1885 (Fed. Cir. 1991). However, nowhere in the Response to the New Office Action did the Applicants make an argument that the Examiner has used an excessive number of references. *See e.g.*, Appendix K. As described above, the problem with the Examiner's arguments does not lie in the number of references but in the hindsight reconstruction of the references. As the Federal Circuit clearly stated, "[i]t is impermissible, however, simply to engage in a

hindsight reconstruction of the claimed invention, using the applicant's structure as a template and selecting elements from references to fill the gaps." *In re Gorman*, 933 F.2d at 987.

8. CONCLUSION

For at least the foregoing reasons, the rejection of all the appealed claims -- claims 14-23 and 25-29 -- set forth in the Final Office Action dated December 9, 2004 should be reversed.

It is the Applicants' belief that no fees are due at this time. However, the Commissioner is authorized to charge any additional fees inadvertently omitted that may be required (except the issue fee) now or during the pendency of this application to JENKENS & GILCHRIST, P.C. Deposit Account No. 10-0447(47079-00124USPT).

Respectfully submitted,

Date: September 29, 2005

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